THE HIGH COURT OF DELHI AT NEW DELHI

% Judgment delivered on:16.05.2007

\+ WP(C) No.3679/2007

MAGOTTEAUX INTERNATIONAL S.A. & ANOTHER ...Petitioners

- versus -

ASSISTANT CONTROLLER OF PATENTS & DESIGNS & OTHERS ...Respondents

Advocates who appeared in this case:

For the Petitioners	:	Mr Ashok Desai, Sr Advocate with Mr Prem Sewak & Ms Shefali Sewak
For the Respondent Nos.1 & 2	:	Mr V. Shekhar, Senior Advocate with Mr S. Ganesh and Mr Zangpo Sherpa
For the Respondent No.3	:	Mr Rajiv Nayyar, Sr Advocate with Ms Rajeshwari Hariharan

CORAM:-

HON'BLE MR JUSTICE BADAR DURREZ AHMED

1. Whether Reporters of local papers may be allowed to see the judgment?

2. To be referred to the Reporter or not?

3. Whether the judgment should be reported in Digest?

BADAR DURREZ AHMED, J (ORAL)

1. The counsel for the parties have been heard at length. The order which is impugned before this court is the one passed on 30.03.2007 by the respondent No.1. Initially, the petitioner had applied for a patent in respect of its product known as "Composite Wear Component". The said application proceeded to the stage of pre-grant opposition. However, during that period four (4) amendments were sought by virtue of an application dated 02.09.2005

moved under Section 78 of the Patents Act, 1970. The pre-grant opposition period expired. No opposition had been received from the public by the respondent No.3. The amendments that were sought by the petitioner were allowed by an order dated 06.09.2005. The petitioner was also granted a patent by virtue of an order dated 02.12.2005. The only thing that remained to be done was the publication of the patent. Thereafter, on 18.01.2006, the respondent No.3 filed an application styled as a review application invoking the provisions of Section 77 (1) (f) as well as Section 78 of the said Act. The prayer in the review application was in respect of 3 out of 4 amendments that had earlier been allowed by the order dated 06.09.2005. This review application was, as indicated by the prayers contained therein, limited to the question of allowing of the amendments. Moreover, the challenge was only restricted to three amendments, out of the four that were granted. The fourth amendment being the amendment whereby the words "consisting of" were replaced by the words "comprising of". There is no objection with regard to this amendment.

2. The review application was dismissed subsequently. Thereafter, various rounds of litigation took place before this court. In the first instance, a writ petition was filed being WP(C) No.7841-42/2006 which was disposed of by an order dated 10.05.2006, whereby orders dated 28.02.2006 and 02.05.2006 were set aside. The matter was remanded to the respondent No.1 to consider

the review application afresh and status quo as available on 18.01.2006 was directed to be maintained. On 28.07.2006, the respondent No.1 dismissed the review application once again but this time on technical grounds. The respondent No.3 filed a petition under Section 227 of the Constitution of India numbered as CM (M) 1152/2006. The same was disposed of by an order dated 20.12.2006 whereby the matter was once again remanded to the respondent No.1 for adjudication on the review application. In other words, the position was the same as had obtained after the issuance of the first order of this court. It is thereafter that the impugned order dated 30.03.2007 has been passed. The operative portion of the order reads as under:-

> "40. It is evident, therefore, that grant of patent shall be made with seal of Patent Office and the date on which the patent is granted shall be entered in the register. On grant of patent the Controller shall publish the fact that the Patent has been granted. Therefore the grant procedure involved four distinct steps
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> a. Grant by Controller on Patent file
> b. According of serial number of Patent
> c. Enntry of grant on register of Patent and issuance of letter of Patent
> d. Publication of grant u/s 43 (2)
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> 41. Therefore, the process of grant completes on completion of all in four ingredients of granting process. In the instant case the procedure at i) and ii) above was completed on 02-12-2005. The grant was entered in the register of Patent on 03-02-2006. The letter of Patent was issued on 13-02-2006. The grant of Patent has not yet been published as per the official records. The public at large get to know about the grant of Patent after publication in the official Journal and if any person is interested to file opposition to the grant of Patent u/s 25(2) of the Indian Patents Act 1970, he gets a period of one year from the date of such publication.

> 42. Considering all the oral and written submission by both the parties present in the hearing and keeping in view the various provisions of the patent law and the direction of the honourable High Court of Delhi, it is hereby ordered that all the "**amendments**" carried out u/s 78 of the Patent Act, 1970 as evident from the file noting of then Controller on 06.09.2005 are not allowable under the said provisions of the Act which deals with "**corrections of clerical errors**" and are hereby, treated as "not allowed". The application for patent is allowed to proceed for further action on the basis of complete specification as found in order for grant on 09.02.2005 except for the phrase "comprising of" which will be substituted by "consisting of" in the complete specification."

3. Mr Ashok Desai, the learned senior counsel appearing on behalf of the petitioners and Mr Rajiv Nayyar, the learned senior counsel appearing on behalf of the respondent No.3 understand the order to read as if the application for patent stands allowed with the amendment of the words "consisting of" being replaced by the words "comprising of". Their further understanding is that the impugned order only relates to the 3 amendments which had earlier been allowed but subsequently disallowed by the impugned order and that in respect of the disallowance of the amendments, the petitioners are free to move an appeal under Section 117 A of the said Act.

4. There is some difficulty with regard to the constitution of the appellate board because, according to Mr Desai, at the time when the applications for patent and amendment were being considered, Mr S. Chandrashekharan was the Controller General. So, he would have dealt with

the said application and he is also a technical member of the Appellate Board. Both counsel agree that the situation can be taken care of by resorting to the remedy provided in the Supreme Court decision in the case of ***Election Commission of India and Another v. Dr Subramaniam Swamy and Another*****: 1996 (4) SCC 104**, wherein the court observed as under:-

> "16. We must have a clear conception of the doctrine. It is well settled that the law permits certain things to be done as a matter of necessity which it would otherwise not countenance on the touchstone of judicial propriety. Stated differently, the doctrine of necessity makes it imperative for the authority to decide and considerations of judicial propriety must yield. It is often invoked in cases of bias where there is no other authority or Judge to decide the issue. If the doctrine of necessity is not allowed full play in certain unavoidable situations, it would impede the course of justice itself and the defaulting party would benefit therefrom. Take the case of a certain taxing statute which taxes certain perquisites allowed to Judges. If the validity of such a provision is challenged who but the members of the judiciary must decide it. If all the Judges are disqualified on the plea that striking down of such a legislation would benefit them, a stalemate situation may develop. In such cases the doctrine of necessity comes into play. If the choice is between allowing a biased person to act or to stifle the action altogether, the choice must fall in favour of the former as it is the only way to promote decision-making. In the present case also if the two Election Commissioners are able to reach a unanimous decision, there is no need for the Chief Election Commissioner to participate, if not the doctrine of necessity may have to be invoked.
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> 17. We think that is the only alternative in such a situation. We are, therefore, of the opinion that the proper course to follow is that the Chief Election Commissioner should call a meeting of the Election Commission to adjudicate on the issue of disqualification of Ms J. Jayalalitha on the grounds alleged by Dr Swamy. After calling the meeting he should act as the Chairman but then he may recuse himself by announcing that he would not participate in the formation of opinion. If the two Election Commissioners reach a unanimous opinion, the Chief

> Election Commissioner will have the opinion communicated to the Governor. If the two Election Commissioners do not reach a unanimous decision in the matter of expressing their opinion on the issue referred to the Election Commission, it would be necessary for the Chief Election Commissioner to express his opinion on the doctrine of necessity. We think that in the special circumstances of this case this course of action would be the most appropriate one to follow because if the two Election Commissioners do not agree, we have no doubt that the doctrine of necessity would compel the Chief Election Commissioner to express his views so that the majority opinion could be communicated to the Governor to enable him to take a decision in accordance therewith as required by Article 192 (1) of the Constitution."

5. In the light of the aforesaid discussion, it is declared that the impugned order relates only to the three amendments which have been disallowed. It is open to the petitioner to move an appeal under Section 117A of the said Act in respect of the disallowance of the three amendments. The patent granted with the fourth amendment (which is not objected to) is directed to be published in accordance with the provisions of Section 43. In the light of the decision of the Supreme Court, in case the appeal in respect of the three amendments is filed by the petitioners, the same shall be heard by the members of the Appellate Board which does not include Mr S. Chandrashekharan, the Technical Member. In other words, the appeal would be heard by the Chairman and the other Member. This special direction is being issued in this matter because it has been demonstrated before the court that the said Mr S. Chandrashekharan had dealt with the matter in his earlier capacity as Controller General of Patents and, more importantly, because both Mr Desai and Mr

Nayyar consent and agree to this course of action so as to prevent a situation of impasse.

This writ petition stands disposed of.

BADAR DURREZ AHMED
(JUDGE)

May 16, 2007
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